

The opinion in support of the decision being entered today was
not written for publication and is not binding
precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW J. HOLMES
and CAMERON W. WATSON

MAILED

MAR 31 2004

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-0937
Application 09/648,325

ON BRIEF

Before KRATZ, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 and 4-6.

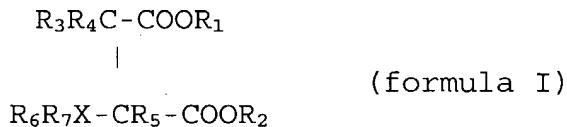
On page 4 of the brief, appellants state that the claims stand or fall together. We therefore consider only claim 1 in this appeal. 37 CFR §1.192(c)(7) and (8)(2003).

Claim 1 is representative of the subject matter on appeal and is set forth below:

1. A hydraulic fluid comprising a lubricant base oil in combination with
 - (a) from 0.001 to 5 %wt of magnesium salicylate,
 - (b) from 0.01 to 8 %wt of zinc dithiophosphate; and
 - (c) from 0.001 to 5 %wt of a compound according to the

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following formula I



in which R_1 and R_2 are each hydrogen or alkyl or hydroxyalkyl of 1 to 30 carbon atoms; R_3 , R_4 and R_5 are each hydrogen or alkyl or hydroxyalkyl of 1 to 4 carbon atoms; X is CH or N and R_6 and R_7 are each hydrogen, alkyl or alkenyl of 1 to 30 carbon atoms, or an acyl group derived from a saturated or unsaturated carboxylic acid of up to 30 carbon atoms.

On page 2 of the answer, the examiner indicates that the rejection of claims 1, and 4-6 under 35 U.S.C. §103 based upon the reference of Dennis has been withdrawn.

The examiner relies upon the following references as evidence of unpatentability:

Matthews et al. (Matthews)	4,462,918	July 31, 1984
Karn	4,627,928	Dec. 9, 1986
Waters et al. (Waters) (EPO)	0 434 464	June 26, 1991
Fujitsu et al. (Fujitsu)	6,114,288	Sep. 5, 2000

Claims 1 and 4-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Waters and Kahn.

Claims 1 and 4-6 stand rejected under 35 U.S.C. 103 as being unpatentable over Fujitsu in view of Matthews.

OPINION

For the reasons set forth in the answer, and below, we affirm each of the rejections.

I. The rejection of claims 1 and 4-6 under 35 U.S.C. § 103 as being unpatentable over Matthews in view of Waters and Kahn

We refer to pages 3-4 of the answer regarding the examiner's position in this rejection, which we incorporate as our own.

Beginning on page 5 of the brief, appellants argue that Waters relates to hydraulic fluids that are zinc free and refers to page 2, line 9 of Waters. Appellants argue then that Waters thus teaches away from a combination of additives that includes a zinc dithiophosphate.

However, as pointed out on page 5 by the examiner, Waters does not indicate that an overbased alkylsalicylate cannot be used in a hydraulic fluid containing heavy metals. Appellants do not dispute this in the reply brief. Hence, we are unpersuaded by appellants' position on this issue.

Also, as pointed out by the examiner on page 5 of the answer, the examiner relies upon Waters for teaching that when a hydraulic fluid is used in an acidic environment, it is desirable to incorporate an overbased alkylsalicylate. The examiner then relies upon Kahn for teaching the specific use of an overbased magnesium alkylsalicylate as an additive for hydraulic fluids, and refers to column 17, lines 41-47 of Kahn. Answer, page 4. Based upon the examiner's position, we disagree with appellants that there would be no motivation to combine Matthews in view of Waters. There is a suggestion to modify in the manner suggested by the examiner.

In view of the above, we determine the examiner has set forth a prima facie case of obviousness.

II. The rejection of claims 1 and 4-6 under 35 U.S.C. § 103 as being unpatentable over Fujitsu in view of Matthews

We refer to pages 4-5 of the answer regarding the examiner's position in this rejection, and incorporate it as our own.

On page 6 of the brief, appellants argue that there is no teaching or suggestion in Matthews that would have led one of ordinary skill in the art to combine Matthews with Fujitsu by adding magnesium salicylate to the composition.

On pages 6-7 of the answer, the examiner rebuts and states that it would have been obvious to include a compound of formula I as taught by Matthews in the lubricating composition of Fujitsu because Fujitsu specifically teaches the addition of such compounds. The examiner states that one of ordinary skill in the art would have been motivated because of the benefit to increase the anti-wear performance of the lubricating composition as taught by Matthews. Hence, we disagree with appellants that there is no suggestion by Matthews to use a compound of the formula I in combination with a Group 2 metal dithiophosphate anti-wear additive for improved anti-wear performance.

In view of the above, we therefore determine the examiner has set forth a prima facie case of obviousness.

III. Rebuttal Evidence

A prima facie case of obviousness is rebuttable, i.e., by proof that the claimed invention possesses unexpectedly advantageous or superior properties. In re Papesch, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963). Upon our review, we find that the comparison/data referred to by appellants in the reply brief is insufficient to rebut the prima facie case of obviousness for the following reasons.

On pages 1-3 of the reply brief, appellants state that their specifically claimed combination provides improved performance at

low load compared with the combination containing calcium salicylate, and appellants refer to page 3, lines 26-33 and page 4, lines 1-3 of their specification. Appellants also refer to Table 1, found on page 12 of the specification, and state that the comparative composition (composition 2) containing calcium salicylate has significantly more ring weight loss and total weight lost than the composition as claimed in the present application containing magnesium salicylate (composition 1).

We observe that composition 1 sets forth specific amounts of magnesium salicylate, zinc dithiophosphate, and the compound of formula 1. The specific amounts, as well as the identity of compound of formula I, are not commensurate with the scope of claim 1 as written. It is necessary that in order to establish unexpected results for a claimed invention, objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support. In re Clemens, 622 F.2d 1029, 1035, 206 USPQ 289, 296 (CCPA 1980); In re Greenfield, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978); In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); In re Tiffin, 448 F.2d 791, 792, 171 USPQ 294, 294 (CCPA 1971).

Also, appellants do not explain why such results would have been unexpected. Results must be explained and shown to be unexpected. In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

In view of the above, we determine that appellants' rebuttal evidence is insufficient to overcome each of the prima facie cases of obviousness of record.

IV. Conclusion

Each of the rejections is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Peter F. Kratz
Peter F. Kratz)
Administrative Patent Judge)

Romulo H. Delmeido
Romulo H. Delmeido)
Administrative Patent Judge)

Beverly A. Pawlikowski
Beverly A. Pawlikowski)
Administrative Patent Judge)

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Kimberly L. Muller
c/o Shell Oil Company
Legal Intellectual Property
P. O. Box 2463
Houston, TX 77252-2463